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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,142	09/17/2003	Nathaniel P. Langford	54493US011	3488
32692	7590	04/08/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EGWIM, KELECHI CHIDI	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 04/08/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,142

Applicant(s)

LANGFORD, NATHANIEL P.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27,28 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27,28 and 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/04/2005 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 27, 28 and 35-40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for adding an additive to a drywall joint compound, wherein said additive reduces the amount of dust generated by sanding the hardened joint compound, does not reasonably provide enablement for adding an additive to a drywall joint compound, wherein said additive reduces the amount of dust generated by the simple hardening of said joint compound. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these

claims. There is no support for an additive reducing the amount of dust generated from simply hardening the drywall joint compound to the degrees claimed by applicant.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 35-37, 39 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (USPN 4,454,267), Struss et al. (USPN 4,686,253), Patel (USPN 5,653,797) or Smith et al. (USPN 4,286,995).

In col. 2, lines 3-6, col. 3, lines 48-50 and Table I, Williams teaches preparing compositions of joint compounds, which invariably contain a filler and a binder (see col. 1, lines 40-47), by admixing in (including through/uniformly mixing with a Hobart N-50 mixer in examples 1-6) at least one dust reducing additive (as defined in page 4, line 31 to page 5, line 4 and page 6, lines 7-11 of the present specifications), such as wetting agents (surfactant) and water (solvent), wherein the joint compounds are applied to the substrate (a drywall/wallboard joint), allowed to dry and subsequently sanded (see col. 2, lines 27-30).

In col. 3, lines 11-15 and 40-47 and table I, Struss et al. teach processes of preparing joint compounds, essentially containing a filler and a binder, by admixing in at

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least one dust reducing additives such as wetting agents (surfactant) and water (solvent), wherein the joint compounds are applied to the substrate (a drywall/wallboard joint), allowed to dry, and subsequently sanded (see col. 8, lines 52-55).

In table IV, Struss et al. also teaches the joint compounds to be prepared with the further addition of aminosiloxane compounds, such as SILWET ® L-77 (See col. 6, lines 64-66), which are surface-active compounds (polymeric **surfactants**).

In col. 7, lines 12-15 and Tables I and II, Patel teaches processes of preparing joint compounds, containing fillers and a binders, by admixing in dust-reducing additives as defined in the present specifications (see page 4, line 31 to page 5, lines 4 and page 6, lines 7-11) including water (solvent), wetting agents (surfactants) and a defoamer such as Nopco 9201 (see Table IVA), which according to Smith et al. (see col. 2, line 16 of Smith et al.), is a vegetable oil compound.

In col. 13, lines 60-67, Patel teaches the joint compounds to be applied to substrate such as wallboard joints and subsequently finished (surface abraded) with reduced time and expense.

In the table in col. 2, Smith et al. teaches a joint compound prepared by admixing water (a solvent), 59% of a limestone (filler), 3.20% of a binder comprising a latex (which necessarily comprises water and a surfactant), propylene glycol (a glycol solvent), a vegetable oil defoamer, etc.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 27, 28 and 38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Williams, Struss et al., Patel or Smith et al.

While Williams, Struss et al., Patel or Smith et al., above, do not expressly teach the recited reduced dust generation and/or dust generation properties, it is reasonable that their joints compounds resulting from the inclusion of the additives would possess the presently claimed dust reducing properties since the "dust reducing additives", as defined by applicant (see 4, line 31 to page 5, lines 4 and page 6, lines 7-11 **including even materials not fitting into any of the recited categories**), are contained/admixed and treated as presently claimed in the prior art joint compounds and therefore the joint compounds are essentially the same as the joint compounds of applicant's claimed processes. In any event, an otherwise old composition resulting from an otherwise old process of compounding is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al., 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Further, even if assuming that the prior art processes do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in

the art, at the time the invention was made, to arrive at the same inventive process because the disclosure of the inventive subject matter appears within the generic disclosure of Williams, Struss et al., Patel or Smith et al.

Response to Arguments

8. Applicant's arguments filed 03/04/2005 have been fully considered but they are not persuasive.

9. Applicant argues that "none of the references disclose a method of reducing the quantity of dust generated by a drywall joint compound by providing a drywall compound ... and then adding to that joint compound, a dust reducing additive", however the step of compounding the additives defined by applicant as dust reducing additives with joint compounds is taught by the prior art.

10. Applicant also argues that "the Examiner's reliance on In re Fitzgerald et al. is misplaced because claim 27 defines a method of reducing dust not a composition." However, since the recited properties are to the composition resulting from the method of compounding the compounds, In re Fitzgerald is apposite.

Applicant is referred to the above citations in the prior art for the inventive subject as disclosed in the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER

